

REMARKS

Favorable reconsideration and allowance of this application are requested.

1. Preliminary Comments

The Examiner's indication of allowability of claims 7-14 and 16-20 subject to their presentation in independent format is noted with appreciation. However, as will become evident from the discussion and attachments presented with this amendment, all claims now pending in this application are in condition for allowance. In this regard, claims 1-4, 6-14 and 16-20 as presented with the applicants' amendment dated March 17, 2009 will remain pending herein for which favorable reconsideration is requested.

2. Response to 35 USC §103(a) Rejections

The only issue remaining to be resolved in this application is the Examiner's rejection of claims 1-4 and 6 under 35 USC §103(a) as allegedly "obvious" from Tung et al (US 2003/0027912) in view of Presenz et al (US 2003/0091823). As will become evident from the following discussion and the attachments submitted concurrently herewith, such a rejection is inappropriate. As such, withdrawal of the rejection is in order.

A. The Reviewing Standards Under 35 USC §103(a) Mandate Withdrawal of the Rejection Based on Tung et al and Presenz et al

Applicants respectfully suggest that the reviewing standards mandated by 35 USC §103(a) have not been met with respect to the combination of Tung et al and Presenz et al. As such, no prima facie case of "obviousness" has been established whereby the rejection advanced under 35 USC §103(a) must be withdrawn.

In this regard, applicants again note that Tung et al deals with a film forming resin composition and use thereof in bottles. This aspect of the Tung et al is repeated throughout Tung et al's disclosure. Thus, although Tung et al might at first blush appear

to be combinable with or modifiable by Presenz et al in a manner that will yield the presently claimed invention, this possibility in and of itself does not render the claimed invention "obvious" under 35 USC §103(a). Specifically, the applied prior art (i.e., Tung et al) must still suggest the desirability of the modification.

The Examiner has summarized the factual inquiries to be made under 35 USC §103 set forth in *Graham v. John Deere Co.*, 382 U.S. 1,148 USPO 456 (1966) (hereinafter "*Graham*") as follows.

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue,
3. Resolving the level of ordinary skill in the pertinent prior art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Tung et al and Presenz et al have apparently been employed to evidence "obviousness" of the presently claimed invention under 35 USC §103(a). Indeed, the Examiner has pointed out all the elements that are nakedly disclosed in Tung et al, the difference between Tung et al and the claims at issue, and that such differences can allegedly be overcome by picking the missing elements from Presenz et al so that the combination of Tung et al and Presenz et al achieves the claimed invention.

However, it appears that there is no indication on the record to indicate why Tung et al is pertinent prior art to begin with and what the level of ordinary skill in the pertinent prior art would be (i.e., *Graham* factors 1 and 3 above). Nor does there appear to be an articulated reasoning why the ordinarily skilled person would be motivated to combine Tung et al with Presenz et al to arrive at the presently claimed invention. In the applicants' view therefore, the rejection advanced on the basis of Tung et al and Presenz et al is inappropriate for several reasons.

The *Graham* decision of course has been extensively discussed in the more recent case *KSR Int'l. Co. v. Teleflex Inc. et al*, 550 U.S. 398 (2007) (hereinafter "*KSR*"). There the Court noted that:

"Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit."¹

After conducting a proper analysis of the prior art, applicants suggest that the inevitable conclusion to be reached is that the presently claimed invention is statutorily *unobvious*.

In this regard, Tung et al is focused on the preparation of compositions used for molding bottles. These compositions are film forming resin compositions (Tung [0016]) and bottles are generally prepared in blow molding process (Tung [0040]). In contrast, the present invention is directed to fiber-reinforced compositions used for injection molding products. An ordinarily skilled person would recognize that compositions for bottles do *not* comprise fibrous reinforcements, since their presence will prevent film forming and obstruct the blow molding. Preparation of fiber reinforced compositions is more complicated than of non-reinforced compositions.

Therefore Tung et al and the presently claimed invention relate to different art areas and problems. As such, Tung et al is not pertinent prior art to the present

¹ *KSR* at 418 citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness").

invention (i.e., is not part of the "scope and content" of the prior art mandated by *Graham*).

Even if Tung et al is considered pertinent, the level of ordinary skill of Tung et al is that of preparation of compositions for molding bottles -- not of fiber-reinforced compositions used for injection molding.

There is no indication in Tung et al that there is need for a composition for other applications. Moreover, there is a restricted group of components that optionally might be comprised by the composition of Tung et al. Furthermore, Tung et al is explicitly affirmative about the properties of its materials, i.e. acceptable color and haze, that there is no suggestion in Tung et al whatsoever, to modify this composition with glass fibers, as this modification would deprive the resulting resin composition from its film forming properties and would make it unsuitable for making bottles.

The person skilled in the art of making compositions for molding bottles, having knowledge of Tung et al and when reading Presenz et al, will notice that the granulate compounds from Presenz et al [0019], which do not comprise fiber reinforcement, can be used for bottles, and that the granulate compounds can be reinforced with glass fiber for applications such as vehicle, optics, household appliances, electrical and electronics. Since the person availing over the ordinary skill of Tung et al is interested in film forming compositions and blow molding of bottles, it would certainly not have been obvious to include the glass fibers of Presenz et al in the process of Tung et al.

In fact for a person skilled in the art of film forming compositions and blow molding of bottles, Presenz et al is teaching away, since the fiber-reinforced products of Presenz et al are suited for other applications, but apparently not for bottles.

Thus Tung et al is not pertinent prior art and Presenz et al would not have prompted a person skilled in the relevant field (of bottles) to combine Tung et al with Presenz et al in such a way to arrive at the presently claimed invention.

What is required by an analysis under 35 USC §103(a) is thus more than merely “cherry picking” words or phrases from one prior art reference and combining it with another. As the Supreme Court also observed in *KSR*:

“...a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.”²

Thus, when the prior art is analyzed properly according to the standards of *Graham* it must be concluded that the presently claimed invention is patentably *unobvious*. That is, the current record does not identify a reason that would have prompted a person of ordinary skill in the field relevant to the present invention to combine the elements in the manner claimed. The only conclusion therefore that can be drawn in the absence of such reasoning is that the rejection based on *Tung et al* and *Presenz et al* is based impermissibly on hindsight.³

² *KSR* at 418-419, emphasis added.

³ The Court of Appeals, Federal Circuit regards hindsight as an insidious and powerful phenomenon and is a tempting, but forbidden zone in the inquiry of addressing the statutory obviousness standard. See, e.g., *Panduit Corp. v. Dennison Mfg. Co.*, 227 USPQ 337 (Fed. Cir. 1985) and *Loctite Corp. v. Ultraseal Ltd.*, 228 USPQ 90, 98 (Fed. Cir. 1985).

KSR also elaborates on results obtained with the applied combination of elements: i.e. the combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.⁴ When a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious. Thus, citing *Sakraida and Anderson's-Black Rock*, it was observed that a "...court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions."⁵

In this respect it is noted that the use of iron particles in the fiber-reinforced molding compositions according to the presently claimed invention results in an improvement that goes far beyond the predictable use of these prior art elements according to their established functions.

Specifically, the iron particles are used in the presently claimed invention to improve the heat ageing properties of the fiber-reinforced molding compositions. For this purpose, combinations of copper halides and alkali halides, more particular CuI/KI, have been used in the art for a long time already. The results that are obtained with the present invention go far beyond those obtained using the art-recognized materials. Thus the elements of the present invention work together in an unexpected and fruitful manner which support the conclusion that the invention is most certainly *not* obvious.

Therefore, based on the analysis above, applicants suggest that the rejection under 35 USC §103(a) based on the combination of Tung et al and Presenz et al is inappropriate and must be withdrawn.

⁴ See, *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969) and *Sakraida v. AG Pro, Inc.*, 425 U.S. 273 (1976).

⁵ KSR at 418.

B. Presenz et al is Not Statutory Prior Art Against the Presently Claimed Invention

Presenz et al is also not statutory prior art against the presently claimed invention. In this regard, there is attached hereto a Declaration Under 37 CFR 1.131 executed by each of the named inventors which establishes that the invention as claimed in the subject application was completed in The Netherlands (a WTO country) prior to the filing date of November 15, 2002 of Presenz et al. For this reason also, therefore, the rejection under 35 USC §103(a) based on Tung et al and Presenz et al must be withdrawn.

3. Fee Authorization

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140.

Respectfully submitted,

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